

REMARKS

No claims have been amended. No claims have been cancelled pursuant to the present reply. Thus, claims 1-31 are pending in the present application.

§ 102 and § 103 Rejections

Claims 1-9 and 11-19 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,976,016 to Moody et al. ("Moody").

Claims 21-31 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,089,976 to Schneider et al. ("Schneider").

Claims 10 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,976,016 to Moody et al. ("Moody") as applied to claims 1 and 11 above, and further

Claims 1 and 11

Claims 1 and 11 were again rejected under 35 U.S.C. § 102(b) as being anticipated by Moody. The Applicants respectfully request the Examiner to reconsider this rejection because the Applicants believe that the Examiner may be misconstruing the claim language.

Claims 1 and 11 require "displaying a plurality of selectable elements associated with respective outcomes" (emphasis added). Yet, in the Final Office Action, it is stated that "the language of present claims 1 and 11 include elements associated with an outcome" (emphasis added). Applicants respectfully point out that the Examiner's position about the outcome being singular – not plural – is not an accurate reading of the claims. Further, while the Final Office Action has focused on the term "associated", it has seemingly overlooked the term "respective", which is an important term in the claims 1 and 11. By "displaying a plurality of selectable elements associated with respective outcomes" (emphasis added), each selectable element has a respective outcome with which it is associated. This claim language is an appropriate and acceptable way to delineate a one-to-one relationship between each element and its respective outcome.

Furthermore, the last element of claims 1 and 11 is "awarding the outcomes associated with the selected element and the at least one of the non-selected elements." In other words, claims 1 and 11 require that at least two outcomes be awarded: one associated with the selected

element and one associated with the non-selected element. This is the “chain-reaction” feature that is indicated in the specification and the title. As such, this last element further emphasizes that the each element, whether it has been selected or is unselected, has a respective outcome with which it is associated.

Moody does not teach these claim elements of claims 1 and 11. Thus, the Applicants respectfully submit that claims 1 and 11, and the claims that depend therefrom, are patentable over Moody under 35 U.S.C. § 102(b) for at least this reason.

Claims 2 and 11 require “revealing the outcomes associated with the selected element and the at least one of the non-selected element at their respective locations” in response to the selection. Moody does not disclose that an outcome associated with a symbol is revealed at a symbol location in response to selection of that symbol. Moody does not disclose that each symbol is associated with an outcome, and the Moody symbols are known to a player at the time of selection. Thus, the Applicants respectfully submit that claims 2 and 11 are patentable over Moody under 35 U.S.C. § 102(b) for at least this reason as well.

Claim 21

Claim 21 requires “conducting the primary game again” in response to a “start-primary outcome in the secondary game.” (emphasis added) The details of this feature are described in paragraph 23 of the present application, which describes FIG. 10. The Final Office Action states that “it is unclear how the applicant intends their game of chance to function without allowing players to place wagers.” Claim 21 specifically states as the first claim element, “receiving a wager from a player.” What is different about claim 21 is that there is a specific outcome (*i.e.*, the start-primary outcome) in the bonus game that causes the primary game to start again without the need for a wager. Again, the claim language requires a “start-primary outcome” which starts the primary game “again.” Schneider simply discloses what is known in the art – when the bonus game is complete, the player can place another wager and replay the primary game. As such, Schneider does not disclose a start-primary outcome in its bonus game that triggers Schneider’s primary game to be conducted again.

Claims 26 and 31

Claim 26 requires that the primary game be “free of slot reels and playing cards.” Similarly, claim 31 requires that the primary game be “other than a slot reel game and a playing card game.” Conversely, Schneider discloses that the primary game includes slot reels and playing cards. Further, claims 26 and 31 also require a secondary game that includes “a plurality of symbol bearing reels that are rotated and stopped to place symbols on the reels in visual association with a display area.” Schneider’s secondary game does not include symbol bearing reels.

Recognizing this deficiency in Schneider, the Final Office Action still attempts to read Schneider on the present claim by swapping Schneider’s primary game and Schneider’s secondary game. While the Applicants understand that the Examiner is to give the claims their broadest reasonable construction, the Applicants believe this construction is not proper. In the Applicant’s view, it is unreasonable to ignore commonly accepted terminology used in wagering-game patents. Skilled artisans surely understand what a “primary game” is and what a “secondary game” is. Not only does the present specification make this clear, but even Schneider uses the same language to refer to the same types of games. In the Abstract, Schneider describes his primary game:

A gaming apparatus and method including a primary game and a player interactive bonus game actuated by a qualifying outcome of the primary game and including a bonus award display showing a multiplicity of images displayed on a video monitor from which a player selects until achieving a pair of matched bonus awards

Later, in the Background section, Schneider discusses the prior art:

For example, the patent to Marnell, II (U.S. Pat. No. 5,393,057) teaches the use of a poker game or reel game for the primary game and a bingo type game as a secondary game. Certain outcomes from the primary game are reflected in the secondary game and, upon the occurrence of orienting the reflected values from the first game to the second game in a pre-agreed upon pattern (resulting in bingo), a secondary award is made to one or more players responsible for the "bingo". Thus, these types of games also fail to

maintain player stimulus as a result of the player being a passive observer of the secondary game.”

The Applicants respectfully request the Examiner to reconsider this rejection as the Examiner’s construction is at directly at odds with (i) the present specification, (ii) the applied prior art, and (iii) commonly accepted language that is used throughout wagering-game patents.

Furthermore, claims 26 and 31 require a “start-secondary outcome” in the primary game that causes the secondary game to start. Even if it were acceptable to swap Schneider’s primary game and secondary game to reject claims 26 and 31, when doing so, one cannot find such a start-secondary outcome in Schneider in Schneider’s “primary” game (as the Office Action alleges), which is really Schneider’s secondary game. Again, FIG. 7 of Schneider simply highlights the fact that Schneider is no different from any other gaming machine -- the primary game can be played after the secondary game is complete by inputting another wager. There is no outcome in Schneider’s secondary game that “starts” the primary game. Thus, the Applicants respectfully submit that claims 26 and 31, and the claims that depend therefrom, are patentable over Schneider.

Conclusion

In conclusion, the Applicants respectfully submit in view of the remarks set forth herein that all rejections have been overcome and that all claims are in condition for allowance, and such action is earnestly solicited.

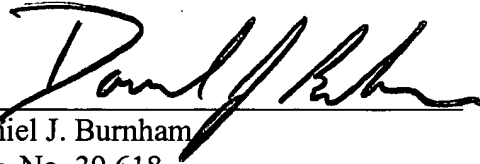
If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants’ undersigned attorney at the number indicated.

Application No. 10/042,620
Response to Office Action dated June 21, 2004
Reply to Final Office Action dated August 23, 2004

The Applicants respectfully submit that no fee is due in connection with the present Reply. The Commissioner is authorized to charge any required fees while this application is pending (except the issue fee) to Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447(47079-00129USPT).

Respectfully submitted,

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Daniel J. Burnham
Reg. No. 39,618
Jenkins & Gilchrist
225 West Washington Street, Suite 2600
Chicago, IL 60606-3418
(312) 425-3900